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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/614,991	07/12/2000	Benjamin Pless	003-006	3292

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EXAMINER
PEFFLEY, MICHAEL F

ART UNIT	PAPER NUMBER
3739	

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/614,991	Applicant(s) PLESS ET AL.	
	Examiner Michael Peffley	Art Unit 3739	

-- Th MAILING DATE of this communication app ars on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 January 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *140-147* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *140-147* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Priority

It is noted that in addition to the applications recited in the Cross Reference to Related Applications section of the specification there are numerous other co-pending applications which disclose and claim very similar and/or identical subject matter. In accordance with 37 CFR 1.105 and MPEP 704.11(a) subsection G, applicant is respectfully requested to disclose all co-pending applications and related patents and identify the specific claims of those applications and/or patents which may present double patenting issues with the instant application claims.

The examiner made a similar request in the previous Office action and applicant noted four other applications by attorney docket number. Additionally, applicant provided a docket report which listed several pending applications and patents. The Office is unable to identify applications by attorney docket number and so the four applications cited on page 3 of the January 28, 2003 response are not identifiable by the examiner. Also, applicant failed to indicate which claims of the instant application correspond to claims in other pending applications. In the extremely lengthy list of related applications, it is noted that several applications have claims directed towards similar and/or identical subject matter. In the interest of thoroughly addressing the double patenting issues between the numerous applications, a multitude of double patenting rejections will be made in the Office actions in each of the pending applications. Applicant is reminded that a response to the Office action must address each rejection and, if applicant feels a double patenting rejection is not warranted, address why a given rejection is not proper.

Double Patenting

The pending claims of this application may conflict with select claims of one or more of the following Application Nos.: 09/606,742; 09/954,393; 09/507,336; 09/698,357; 09/699,150; 09/698,639; 09/699,215; 09/884,435; 10/171,411; 10/171,390; 10/172,732; 10/171,389; 10/232,963; 10/232,964; 10/008,904; 10/010,409; 10/006,064; 10/008,997; 10/006,088; 10/077,470; 10/238,821; 10/238,937; 10/255,134. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

The currently pending claims of this application are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of select claims of one or more of copending Application Nos. 09/606,742; 09/954,393; 09/507,336; 09/698,357; 09/699,150; 09/698,639; 09/699,215; 09/884,435; 10/171,411; 10/171,390; 10/172,732;

10/171,389; 10/232,963; 10/232,964; 10/008,904; 10/010,409; 10/006,064; 10/008,997; 10/006,088; 10/077,470; 10/238,821; 10/238,937; 10/255,134. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The currently pending claims of this application are rejected under 35 U.S.C. 101 as claiming the same invention as that of select claims of one or more of prior U.S. Patent Nos. 6,161,543; 6,237,605; 6,311,692; 6,314,962; 6,314,963; 6,484,727; 6,474,340. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

The currently pending claims of this application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over select claims of one or more of U.S. Patent Nos. 6,161,543; 6,237,605; 6,311,692; 6,314,962; 6,314,963; 6,484,727; 6,474,340. Although the conflicting claims are not identical, they are not patentably distinct from each other because the various method steps and device parameters are deemed obvious.

The currently pending claims of this application are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over select claims of one or more of copending Application Nos. 09/606,742; 09/954,393; 09/507,336; 09/698,357; 09/699,150; 09/698,639; 09/699,215; 09/884,435; 10/171,411; 10/171,390; 10/172,732; 10/171,389; 10/232,963; 10/232,964; 10/008,904; 10/010,409; 10/006,064; 10/008,997; 10/006,088; 10/077,470; 10/238,821; 10/238,937; 10/255,134. Although the conflicting claims are not identical, they are not patentably distinct from each other because the various method steps and device parameters are deemed obvious.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 140-147 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcus et al ('484).

Marcus et al provides an ablating device which includes a plurality of ultrasonic transducers (i.e. an array). Column 9, lines 5-24 specifically address an example whereby three transducers are used to provide three different frequencies for creating lesions in cardiac tissue. Marcus et al teach the use of the device to create lesions in

cardiac tissue, as well as using the device to create multiple lesions at multiple locations. The only features not expressly taught by Marcus et al are the specific focal lengths of the transducers.

The examiner maintains that the particular focal length would depend on the tissue being treated and the results desired and would be an obvious design consideration for one of ordinary skill in the art. Moreover, the examiner maintains that one of ordinary skill in the art would be aware that a focal length of 2-20mm would be in an obviously acceptable range of focal lengths for creating lesions in cardiac tissue.

To have provided the Marcus et al transducers with any obviously acceptable focal length for the creation of lesions in cardiac tissue would have been an obvious modification for one of ordinary skill in the art.

Conclusion

It is noted that applicant has filed literally thousands of claims in the dozens of applications/patents cited. Many claims are canceled/added to each application, and there is a substantial repeat of claimed subject matter in many of the applications. The above double patenting rejections are an effort to discern what is effectively being claimed in each application and ensuring that overlapping subject matter is not issued in multiple patents. Since the double patenting rejections were not previously set forth, this action is non-final.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on Mon-Fri from 6am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Michael Peffley
Primary Examiner
Art Unit 3739

mp
March 10, 2003

JOHN E. KITTLE
DIRECTOR TC 3700